

U.S. Patent Appln. S.N. 09/847,384  
AMENDMENT AFTER FINAL REJECTION

PATENT

REMARKS

This Amendment cancels claim 33 in favor of new claim 51, and amends the dependencies of claims 34-36, 38, 40, 41, 46, 48 and 50 accordingly. New claim 51 generally corresponds to canceled claim 33; however, the three formulae for Z have been corrected by deleting the substituent R. R is a protective group and is linked to the 5'-oxygen farthest to the left in each of the three Z formulae. This correction makes the three formulae of Z consistent with Formula (I) recited at the beginning of claim 51, and is supported in the specification by the compounds of the examples; see e.g. the product compound of Scheme 2 (page 39), compound 7 (Scheme 3A, page 40), compound 9 (Scheme 3B, page 41), compound 12 (Scheme 4, page 42), compound 18 (Scheme 5B, page 44), compound 26 (Scheme 7A, page 47), compound 27 (Scheme 7B, page 48), compound 37 (Scheme 8B, page 50) and the compounds of Schemes 9 and 10 (pages 51 and 52). In each of these examples, the protecting group is either DMTr (4, 4'-dimethoxytrityl) or R is not present (i.e. R is hydrogen).

The positions where the R group had erroneously been placed in the three Z formulae in claim 33 are in fact the positions for A. This is also evident from the compounds of the examples; see e.g.

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the product compound of Scheme 2 (page 39), compound 12 (Scheme 4, page 42), compound 18 (Scheme 5B, page 44), compound 27 (Scheme 7B, page 48), compound 37 (Scheme 8B, page 50) and the compounds of Schemes 9 and 10 (pages 51 and 52). In each of these examples A is either a phosphorylating moiety or a solid support tethered to Z via a linking arm. Claims 34-51 are pending.

Entry of this Amendment is respectfully requested, as it is believed (1) to place the application in condition for allowance, (2) not to raise any new issue or require further search by the Examiner, (3) to be directly responsive to the Official Action, and (4) to place the application in even better form for appeal, should such appeal be necessary.

This Amendment overcomes the objection to claim 50. More particularly, claim 50 has been amended to depend from new claim 51, thereby mooting the ground for objection. Reconsideration and withdrawal of the objection to claim 50 are earnestly requested.

This Amendment overcomes the 35 U.S.C. § 112, first paragraph, rejection of claims 33-49 for failure to comply with the written description requirement. More particularly, claim 33 has been canceled in favor of new claim 51, which does not require attachment of A to the 5' oxygen. Reconsideration and withdrawal

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of the 35 U.S.C. § 112, first paragraph, rejection of claims 33-49 are earnestly requested.

This Amendment also overcomes the 35 U.S.C. § 112, second paragraph, rejection of claims 33-49. Formula (I) of new claim 51 unambiguously identifies R as a protecting group or as hydrogen. One of ordinary skill in the art would understand if R were not a protecting group it would be hydrogen, as evident from some of the compounds of the examples such as those in Schemes 9 and 10. Reconsideration and withdrawal of the indefiniteness rejection of claims 33-49 are earnestly requested.

It is believed this application is in condition for allowance. Reconsideration and withdrawal of all objections and rejections of claims 33-50, and issuance of a Notice of Allowance directed to claims 34-51, are earnestly requested. The Examiner is urged to telephone the undersigned should he believe any further action is required for allowance.

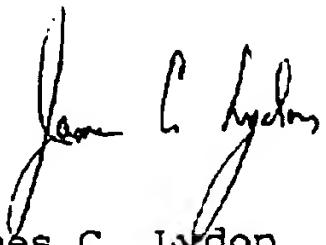
It is not believed any fee is required for entry and consideration of this Amendment. Nevertheless, the Commissioner is

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authorized to charge our Deposit Account No. 50-1258 in the amount  
of any such required fee.

Respectfully submitted,

  
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